

## REMARKS

Claims 1-4 and 6-9 stand rejected and are presently pending in the application. Favorable reconsideration in view of the following remarks is earnestly solicited.

### **Rejection under 35 U.S.C. § 103(a) over Asgharian et al.:**

The Examiner has rejected claims 1-4 and 6-9 under 35 U.S.C. § 103(a) as being unpatentable over Asgharian et al (U.S. 6,139,646). The Examiner indicates that Asgharian et al. teaches the use of a simple saccharide in a composition that contains PHMB. However, the Office Action dated January 13, 2009 fails to set forth a *prima facie* case of obviousness.

### **Asgharian fails to teach all of the claimed limitations:**

Asgharian relates to improving the stability of liquid enzyme solution containing both covalently modified trypsin and water using organic stabilizers. The stabilizers compete with water in the hydrogen bonding of the liquid enzyme solution to reduce the water-hydrogen bonding necessary for enzyme activity.

The instant claims relates to a effective single-part aqueous solution with a specific combination and concentrations of a preservative enhancer, polyhexamethylene biguanide and chloride. The inventive solution is effectively preserved while reducing the amount of preservatives deposited on contact lenses.

Asgharian teaches a two-part solution where trypsin is an active ingredient in a first part that is combined with the second part. The second part contains sorbitol with a concentration of 1.2 weight/volume. There is no indication that the second solution would be effective as a contact lens solution by itself. Indeed, Asgharian teaches that the second part, the solution, need be combined with the first component containing trypsin to be effective. By contrast, the present claims recite a single-part solution that is effective as a contact lens solution without the need to combine with a second part. The omission of an element and the retention of its function is an indicia of non-obviousness. *In re Edge*, 359 F.2d 896, (CCPA 1966). As Asgharian does not teach a single-part

solution it respectfully urged that Asgharian fails to teach or suggest all of the claimed limitations.

The January 13, 2009 Office Action fails to address all of the claimed limitations:

The Amendment filed October 29, 2008 amended the claims to recite an aqueous solution that is effective as a single-part-solution. As discussed above, Asgharian teaches a multi-part solution that must be combined to be effective. As the Office Action dated January 13, 2009 fails to address all of the claimed limitations it is requested that this rejection be reconsidered withdrawn.

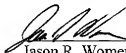
Applicant respectfully submits that Claims 1, 8 and 9 and all claims that depend therefrom are therefore in condition for allowance.

Applicant appreciates the opportunity to call the Examiner but believes that the forgoing remarks fully address the issues raised by the Examiner. On the other hand, the Examiner is invited to call the undersigned attorney if he has any matters to address that will facilitate allowance of the application.

In the event that Applicant has overlooked the need for an extension of time, additional extension of time, payment of fee, or additional payment of fee, Applicant hereby conditionally petitions therefore and authorizes that any charges be made to Deposit Account No.: 50-3010.

Respectfully submitted,

HISCOCK & BARCLAY, LLP



Jason R. Womer  
Reg. No. 60,149  
2000 HSBC Plaza  
100 Chestnut Street  
Rochester, NY 14604  
Telephone: (585) 325-7570 x-4306  
Fax: (585) 295-8431